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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,414	08/03/2001	Bruno Alexander Korngold	005032-00036	7466

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EXAMINER

NOLAN JR, CHARLES H

ART UNIT PAPER NUMBER

2854

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/922,414

Applicant(s)

KORNGOLD ET AL.

Examiner

Charles H Nolan, Jr.

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9-22-03 and 1-27-04.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-24 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 5 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 0 926 552 A1 to Haydock, hereafter “‘552.”

With respect to Claim 5, Haydock teaches the use of ISO holes(index holes) to measure the start of quality problems(imperfections) on page 2 @[0008]-[0009].

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by GB 2 169 402 A to Derrick, hereafter “‘402.”

With respect to Claim 1, ‘402 teaches the position indicating mark 8 in figure 1a, the synchronization of the down web coordinate of the mark on page 1, lines 54-60.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over ‘402 in view of Takahashi et al. (5,935,361, hereafter “‘361”).

With respect to Claim 6, '402 teaches the detection system in figure 2, the product inspection system 6-7 in figure 1b, the data processing system (counter) and conditioning electronics in figure 2 and page 2, lines 60-73. '402 teaches all the claim limitations except for the ISO hole puncher. '361 teaches the ISO hole puncher in column 6, lines 45-50. The motivation to combine the references is that each invention has the same endeavor of identifying defective areas on a web. It would have been obvious to replace the heavy metal disk marks of '402 with the ISO holes of '361 so as to eliminate the need for time consuming human inspection and rolling up scrap webs as taught by '361 in column 1, lines 43-45.

6. Claims 2-5 and 7-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over '552 in view of '402 in further view of '361.

The dependent claims additionally recite conventional features already addressed such as ISO hole and electronic circuits that utilize digitized information and order of the web length measurement.

Response to Arguments

7. Applicant's arguments filed 9-22-03 and 1-27-04 have been fully considered but they are not persuasive. Applicant, who has employed new counsel, argues in the response dated 9-22-03 that the '402 reference does not anticipate independent claim 1 because Applicant defines "down-web" as an orientation in the winding direction of a web that is winded on a roll. This argument is not persuasive because of the language of claim 2 which explicitly states a roll. If Applicant meant for down web to mean a roll, why is it excluded from claim 1 by the recitation of roll in claim 2? Further, when a roll is

explicitly recited in claim 2, art is applied(see '552 reference). Additionally, independent claim 6 is not read to mean a roll of product wound around a reel because this limitation is missing from independent claim 6. In the response dated 1-27-04 by Applicant's new counsel, Applicant states that independent claim 5 is not rendered obvious by the prior art combination because, inter alia, "Nowhere does the '361 reference teach or suggest indicating a quality problem area on a web...with an ISO hole." Applicant, then , contradicts this statement by stating "The use of ISO holes in this reference is merely to indicate the position of a splice." The Examiner notes that a splice is a quality problem or defect that would have been recognized by one of ordinary skill in the art. In the response dated 9-22-03, Applicant argues that there is no motivation to combine the references applied to claim 6. The examiner disagrees. It is noted that the applied references are trying to solve the same problem of detecting defects(quality problems) on objects in a printing environment.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

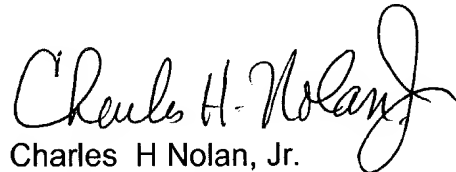
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H Nolan, Jr. whose telephone number is 571-272-2171. The examiner can normally be reached on Monday through Thursday 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charles H Nolan, Jr.
Primary Examiner
Art Unit 2854

CHN